

REMARKS

Summary of the Office Action

Claims 1-9 stand rejected under 35 U.S.C. § 112, first paragraph.

Claims 1, 4, and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Endo et al.* (USPN 6,016,174).

Claims 19-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Watanabe et al.* (USPN 5,966,589).

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe et al.* (USPN 5,966,589) in view *Endo et al.* (USPN 6,016,174).

Claims 6-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe et al.* (USPN 5,966,589) in view *Endo et al.* (USPN 6,016,174) and further in view of Applicants' allegedly admitted prior art.

Summary of the Response to the Office Action

Claims 1 and 19-20 have been amended. Accordingly, claims 1-20 are presently pending with claims 1-9 and 19-20 being under consideration.

The Rejections Under 35 U.S.C. § 112

Claims 1-9 stand rejected under 35 U.S.C. § 112, first paragraph. Applicants have amended claim 1 in accordance with the comments of the Examiner. With respect to claim 6, Applicants respectfully request that this portion of the rejection be reviewed because the language referred to as claim language of claim 6 in the Office Action, is not recited in claim 6.

Thus, Applicants respectfully request that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

The Rejections Under 35 U.S.C. §§ 102(b) and 103(a)

Claims 1, 4, and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Endo et al.* (USPN 6,016,174). Claims 19-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Watanabe et al.* (USPN 5,966,589). Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe et al.* (USPN 5,966,589) in view *Endo et al.* (USPN 6,016,174). Claims 6-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Watanabe et al.* (USPN 5,966,589) in view *Endo et al.* (USPN 6,016,174) and further in view of Applicants' allegedly admitted prior art. Applicants traverse the rejections for at least the following reasons.

i. Claim 1

With respect to independent claim 1, Applicants respectfully assert that neither *Watanabe et al.* nor *Endo et al.*, whether taken singly or combined, teach or suggest a combination wherein an anisotropic conductive film and an insulating film cover the entire upper and side surfaces of transparent conductive layers. The Office Action recognizes that *Watanabe et al.* does not disclose this feature. However, the Office Action alleges that *Endo et al.* (especially at column 12, lines 12-17) teaches an anisotropic conductive film covering entire upper and side surfaces of the transparent conductive layers. Applicants respectfully disagree. *Endo et al.* discloses that the contact hole is completely covered with the anisotropic conductive film and, therefore, only relates to the contact hole portion. As a result, Applicants respectfully assert that this passage of

Endo et al. is insufficient to disclose an anisotropic conductive film and an insulating film cover the entire upper and side surfaces of transparent conductive layers.

ii. Claim 6

With respect to independent claim 6, Applicants respectfully submit that there is no motivation to combine the grinding area of Applicants allegedly admitted prior art with the teachings of *Watanabe et al.* and/or *Endo et al.* Here, the Office Action has asserted that “it would have been obvious for one of ordinary skill in the art at the time of the invention to have a grinding area in the pad structure of Watanabe because APA teach that this is conventional in the art.”

In the Amendment filed July 31, 2003 (albeit with respect to a different rejection), Applicants also respectfully asserted that the Office Action has cited no motivation to modify the teachings of the primary reference in that Office Action with those of Applicants’ allegedly admitted prior art. Specifically, it was argued that, while Applicants’ allegedly admitted prior art does indicate that a grinding area is one technique sometimes used in the conventional art, merely being conventional art is not a motivation to modify the teachings of the primary reference in that Office Action. In response, the Final Office Action asserts that “in the absence of a teaching away from the conventional wisdom, one of ordinary skill in the art would be especially motivated to use conventional wisdom because it saved enormous amounts of time, money, and labor.” However, neither the Final Office Action nor the current Office Action has not provided any evidence or other showing that the grinding area has any association or benefit with respect to saving “time, money, and labor.” Accordingly, if this line of reasoning is being

maintained, Applicants respectfully request that documentary evidence of the Final Office Action's assertion be provided.

In addition, while applicants have presented Figures 1 and 2 as relating to a "conventional" art, it is not intended to suggest that all LCD pad structures use a grinding area. While the use of a grinding area is one type of structure conventionally used, it is not the only type of structure conventionally used. Applicants respectfully submit that it appears that *Endo et al.* relates to a different structure convention than that of Applicants' allegedly admitted prior art because it appears to be of a type not using a grinding area. (For example, while automatic transmissions are conventional in the automotive arts, not all automobiles use automatic transmissions and there would be no necessary reason to apply automatic transmission techniques in manual transmission automobiles because the two use different conventions.)

Further, Applicants respectfully assert that presence of the grinding area is related to the present invention. Specifically, a part of the inventive process included the recognition that the exposed ends after the grinding portion increases the possibility of atmospheric corrosion or electrolytic corrosion, thereby leading to damage of the pad. Consequently, the present invention seeks, in part, to overcome these problems. However, without a grinding area, the structures of *Watanabe et al.* and/or *Endo et al.* would not be affected by such problems, and therefore, one of ordinary skill in the art would not be motivated to modify these references to achieve the combined references.

Thus, Applicants respectfully asserts that the Office Action has improperly asserted obviousness without a suggestion or motivation in the prior art. MPEP § 2145(X)(C) instructs

that “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings.” Also, MPEP § 2143.01 instructs that “a statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art’ at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).” Moreover, MPEP § 2143.01 instructs that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).”

iii. Claims 19-20

Applicants respectfully submit that independent claims 19-20 are allowable at least for reasons similar to those presented above with respect to independent claim 6.

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Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(b) and 103(a) should be withdrawn because the applied art does not teach or suggest each feature of independent claims 1, 6 and 19-20. Furthermore, Applicants respectfully assert that dependent claims 2-5, and 7-9 are allowable at least because of their respective dependence from independent claims 1 and 6, and the reasons set forth above.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

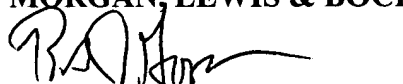
If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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Date: July 14, 2004

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